

REMARKS

In the Final Office Action mailed on May 21, 2003, claims 2-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan et al. (U.S. Patent No. 6,421,657) and Gaffaney et al. (U.S. Patent No. 5,634,008). The foregoing rejections are respectfully traversed.

Claims 2-20 are pending in the subject application, of which claims 2, 13, 16, and 19 are independent.

Entry of Amendment After Final Rejection:

The Applicant respectfully asserts that the amendments presented herein require only a cursory review by the examiner, and respectfully requests that the examiner enter such amendments.

Amendments to the Claims:

Independent claims 2, 13, 16, and 19 of the subject application are amended herein to recite that the importance degree mark is displayed "for the unique identifying information." Care has been exercised to avoid the introduction of new matter.

Support for the amendments to claims 2, 13, 16, and 19 may be found in the Specification at page 11, lines 17-19.

Rejections of the Claims:

Differences between the claimed invention and the cited references:

In item 5, on page 3 of the Office Action, the examiner states that neither Ryan nor Gaffaney specifically shows the display of the importance mark, but the examiner further states that Gaffaney shows the display of alert and information marks on a terminal display, citing column 4, lines 1-12 and 26-33 of Gaffaney. Apparently, the examiner is interpreting Gaffaney's alert as the importance degree mark of the claimed invention.

In contrast, independent claims 2, 13, 16, and 19 of the subject application (as amended

herein) recite "setting an importance degree mark, which is to be displayed for the unique identifying information on the display unit." Specifically, the importance degree mark in the present invention is associated with the URL, whereas in Gaffaney, an alert is displayed, but the alert does not correspond to a displayed URL. For example, in the present invention, as discussed in regard to Figure 8, underlining is an importance degree mark.

Lack of motivation to combine the cited references:

In item 14, on page 5 of the Office Action, the examiner responded to the Applicant's argument that the motivation to combine Ryan and Gaffaney was not sufficiently set forth in the October 9, 2002 Office Action by stating that the motivation is proper because Ryan shows "the need to update counts to determine importance or relevance of a network site," and Gaffaney shows "a common way in the art to do so." Unfortunately, the examiner's reasoning still falls short of the required standard, as argued in the March 6, 2003 Amendment.

As argued in the March 6, 2003 Amendment, MPEP § 706.02(j) sets forth the contents of a rejection under § 103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure" (emphasis in original).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60

USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The examiner has not presented any evidence why Ryan and Gaffaney would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The examiner's sole support for such a combination is that "it would provide a convenient way to determine importance or relevance of a network site in a system that updates counts of network site access" (Office Action, p. 3, item 6). The examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the examiner has not presented any actual evidence in support of the same. Instead, the examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Because the examiner still has not satisfied the required standard (in two consecutive Office Actions), as set forth by the Federal Circuit, the combination must be withdrawn.

Conclusion:

Therefore, independent claims 2, 13, 16, and 19 of the subject application (as amended herein) are patentably distinguishable over the cited references. In addition, dependent claims 3-12, 14-15, 17-18, and 20 of the subject application are allowable based in part on their dependency, directly or indirectly, from one of allowable independent claims 2, 13, 16, and 19.

Withdrawal of the foregoing rejections is respectfully requested.


There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal

matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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